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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Walke *et al.*

Group Art Unit: 1647

Application No.: 09/893,321

Examiner: R.S. Landsman

Filed: June 27, 2001

Title: Novel Human GABA Receptors and
Polynucleotides Encoding the Same

Attorney Docket No.: LEX-0195-USA

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RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

Commissioner for Patents
Washington, D.C. 20231

Sir:

The Examiner is respectfully requested to accept the following response to the Restriction and Election Requirement mailed September 3, 2002 (Paper No. 7), to consider the remarks therein.

Restriction Requirement

The Examiner has determined that the original claims are directed to two separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1 in part , 2 and 3, said to be drawn to an isolated nucleic acid molecule related to SEQ ID NO:1 and encoding SEQ ID NO:2, classified in class 536, subclass 23.5.
- Group II: Claims 1 in part , and 4, said to be drawn to an isolated nucleic acid molecule related to SEQ ID NO:3 and encoding SEQ ID NO:4, classified in class 536, subclass 23.5.

Response to Restriction and Election Requirement

In response to the Restriction Requirement mailed September 3, 2002 (Paper No. 7), Applicants elect with traverse to prosecute the claims of Group I, comprising Claims 1 in part , 2 and 3, said to be drawn to an isolated nucleic acid molecule related to SEQ ID NO:1 and encoding SEQ ID NO:2, classified in class 536, subclass 23.5. Applicants further elect, pursuant to 35 U.S.C. § 121,

the species of SEQ ID NO: 1 for initial examination on the merits. Elected Claims 1-3 read on the elected species. Applicants understand their species election is being made solely to expedite examination of the application, and that they are entitled to consideration of additional species upon allowance of a generic claim. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

Applicants' traverse is respectfully based on the fact that the nucleic acid sequences described in SEQ ID NOS: 1 and 3 (and the amino acid sequences they encode, SEQ ID NOS: 2 and 4) are all encoded by a common genetic locus and because the nucleic acid of SEQ ID NO:3 is entirely contained within the nucleic acid sequence of SEQ ID NO:1. The nucleic acid of SEQ ID NO:3 results from an early termination signal in the nucleic acid sequence of SEQ ID NO:1. Thus, SEQ ID NO:3 is conceptually a fragment of SEQ ID NO:1. To assist the Examiner in recognizing this relationship, Applicants submit a nucleotide BLAST report (**Exhibit A**) comparing the nucleic acid of SEQ ID NO:1 with that of the nucleic acid sequence of SEQ ID NO:3. Given the described relationship between SEQ ID NO:1 and SEQ ID NO:3, Applicants respectfully submit that these inventions are not distinct, for the purposes of electronic searching, and that by searching SEQ ID NO:1 the Examiner will have effectively searched SEQ ID NO:3 and thus do not result in an undue search burden. Accordingly, Applicants respectfully submit that Groups I and II (Claims 1-4) should be combined into a single group.

Additionally, it is Applicants' belief that the original Markush Claim 1 was proper. MPEP § 803.02 states:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

All of the claims in the present invention read on variants of a novel human GABA receptor. One of skill in the art would therefore agree that they share a common utility and, as variants, they share substantial structural features.

Although Applicants believe that no additional fees are due in connection with this response, the Commissioner is authorized to charge any underpayment or credit any overpayment required with this response to Deposit Account No. 50-0892.

Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should the Examiner have any questions or comments a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

10/2/02
Date


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